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Paper No. 9
AD

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Gary L. Green, P.A.

Serial No. 75/642,176

Mark Rogers of Speed & Rogers for Gary L. Green, P.A.

Vivian Micznik First, Trademark Examining Attorney, Law
Office 104 (Sidney Moskowitz, Managing Attorney).

Before Simms, Bucher, and Drost, Administrative Trademark
Judges.

Opinion by Drost, Administrative Trademark Judge:

Gary L. Green, P.A. (applicant) filed an application
to register on the Supplemental Register the mark WE MAKE
HOUSE CALLS (in typed form) for "legal services" in
International Class 42. The application (Serial No.
75/642,176) was filed on February 17, 1999, and applicant
claimed a date of first use and a date of first use in
commerce of October 1, 1998.

The Examining Attorney has refused to register
applicant's mark on the ground that "regardless of the

manner of use of the phrase WE MAKE HOUSE CALLS, the words will not function as a mark because they will be perceived as informational matter." Examining Attorney's Appeal Br., p. 5. At this point, we should note that the Examining Attorney¹ stated the mark was refused registration because it did not function as a mark under Sections 1, 2, and 45 of the Trademark Act. 15 U.S.C. §§ 1051, 1052, and 1127. However, since applicant has consistently sought registration on the Supplemental Register, the issue is not whether the slogan functions as a mark, but whether the slogan is capable of functioning as a mark. In re Eilberg, 49 USPQ2d 1955, 1956 n.2 (TTAB 1998). In essence, the Examining Attorney's position is that applicant's slogan is purely information matter that would never be recognized as a trademark, and it is, therefore, incapable of registration on the Supplemental Register. Applicant seems to have understood that the ultimate issue was always whether its slogan was capable of functioning as a trademark. See Applicant's response dated January 26, 2000, p. 4 ("[I]t is respectfully submitted that the slogan WE MAKE HOUSE CALLS distinguishes, or at a minimum is

¹ The current Examining Attorney was not the original Examining Attorney in this case.

capable of distinguishing, the applicant's services from those of others"); Applicant's Appeal Br., pp. 6-7 (same). Therefore, we now consider whether applicant's slogan is capable of distinguishing applicant's services from those of others.

In refusing registration, the Examining Attorney relies on the following evidence. First, she has submitted a definition that a "house call" is a "professional visit made to a home by a professional, especially by a physician." Second, she has submitted a significant amount of evidence that the term "house call" is used to describe a home visit by many types of professionals. Third, she has also introduced evidence that attorneys visit clients in their homes, and that these visits are referred to as "house calls." Based on this evidence, the Examining Attorney argues that applicant's slogan should be refused registration on the Supplemental Register.

Applicant responded by pointing out that there is no evidence that any other attorney uses the exact phrase "we make house calls," consumers are not accustomed to the use of "such claims by lawyers," and its phrase is featured in

a distinctive and highly stylized fashion.² Applicant's Appeal Br., pp. 4-5.

After the Examining Attorney made the refusal to register applicant's slogan on the Supplemental Register final, applicant filed a notice of appeal. Applicant and the Examining Attorney have filed briefs. No oral hearing was requested.

Because we hold that applicant's slogan is incapable of distinguishing applicant's services from those of others, we affirm the refusal to register.

Applicant's mark consists of the slogan WE MAKE HOUSE CALLS in typed form for legal services.

The determination of whether or not a given expression or combination of words is capable of distinguishing an applicant's goods is grantedly not an easy one, but it seems apparent that every combination of words cannot accomplish this purpose and that in order to be registrable on the Supplemental Register, a laudatory expression must have some degree of ingenuity or say something in a slightly different way from that expected to be said about a product.

In re O.R. Mossberg & Sons, Inc., 175 USPQ 191, 192 (TTAB 1972) (MORE GUN FOR THE MONEY for rifles and shotguns incapable of registration on the Supplemental Register).

See also In re Helena Rubinstein, Inc. 419 F.2d 438, 161

² The Examining Attorney properly objected to applicant's list of registrations, which was unaccompanied by a copy of the referenced registrations. In re Duofold Inc., 184 USPQ 638, 640 (TTAB 1974).

USPQ 606, 608 (CCPA 1969) ("A term "cannot be registered as a trademark, even on the Supplemental Register, unless it is intended primarily to indicate the origin of the goods and is of such a nature that the ordinary purchaser would be likely to consider that it indicated such origin").

Recently, the Federal Circuit held that the slogan THE BEST BEER IN AMERICA for beer and ale was a "common, laudatory advertising phrase" that "is incapable of registration as a trademark." In re Boston Beer Co., 198 F.3d 1370, 53 USPQ2d 1056, 1058 (Fed. Cir. 1999).

Whether applicant's mark is capable of distinguishing its services from those of others must be determined on the basis of the significance or meaning of the mark as applied to the services, the context in which the mark is used in the specimens, and the likely reaction of the average consumer encountering the mark in its natural environment.

See In re Brock Residence Inns, Inc., 222 USPQ 920, 922 (TTAB 1984), citing, In re Western Union Telegraph Co., 199 USPQ 499 (TTAB 1978). First, we look at the meaning of the mark. Applicant's slogan is a simple slogan that says "we make house calls." A house call is defined as a professional visit made to a home, especially by a physician. The Examining Attorney has made numerous articles of record to demonstrate that many professions

make visits that are identified as "house calls." See, e.g., First Office Action, Stories 2, 411, 413, 423, 600 (veterinarians); Stories 5, 406, 407, 419 (doctors); Story 8 (aquarium installers); Story 9 (nursing students); Story 13 (pet photographers); Story 204 (grandfather clock repairman); Stories 400 and 815 (computer repairmen); Story 417 (hairstylist); and Story 603 and 1004 (massage therapists).

Indeed, in addition to these professions, the Examining Attorney's evidence shows that attorneys also make calls.

In their commercials, lawyers say they'll make **house calls**. Wouldn't you like to see doctors on TV promise the same? *The Virginian-Pilot*, April 8, 1999, p. E2.

[The] common goal is to bring lawyers and elderly clients together, says McBride, primarily by establishing clinics and through what essentially are **house calls**. *ABA Journal*, March 1999, p. 89.

When Rudman makes **house calls**, people are more comfortable because they're in their own homes and, as a result, are more candid. *New Jersey Lawyer*, April 27, 1998, p.1.

Forms are printed in large type. The office is physically accessible. Lawyers make **house calls**. *Chicago Lawyer*, November 1997, p. 1.

In his quest for clients in a town stuffed with lawyers, Pena offered the rare service of **house calls**. *Austin American-Statesman*, June 19, 1997, p. D1.

Caruso said he's a lawyer who makes **house calls** for his clients who are housebound. *Times-Union*, November 4, 1994, p. B4.

It's not a coincidence that doctors no longer make **house calls**, but lawyers do. In fact, you can see the advertisements for such lawyers on television. *Sun-Sentinel*, June 28, 1994, p. 1A.

The evidence shows that the slogan "we make house calls" will have a readily understood meaning, i.e. that the lawyers will make a professional visit to a prospective client's home.

The context in which the slogan is used on applicant's specimens reinforces that meaning. The large Yellow Pages advertisement has a picture in the upper hand corner that is apparently a simulation of an attorney making a house call. Underneath the photograph is the italicized slogan *We Make House Calls*. To the right of the picture and slogan is the following information:

PERSONAL INJURY AND WRONGFUL DEATH CASES
MEDICAL NEGLIGENCE
TRACTOR TRAILER WRECKS
TRAUMATIC BRAIN INJURIES
BIRTH INJURIES

NO RECOVERY, NO FEE
Client may Be Responsible for Costs or Expenses

Home & Hospital Consultation Available for the Seriously Injured

The rest of the advertisement contains the firm name and contact information, a notation that "A donation to MADD is made by this law firm in recognition of every victim we represent against a drunk driver," and a seal

containing, inter alia, the name of the firm, the large, stylized letters GG, and the slogan "We Make House Calls." Applicant's smaller Yellow Pages advertisement is similar although, in addition to being smaller, it does not contain the photograph of the simulation of the house call, which was featured in the larger advertisement.

In these specimens, the phrase "we make house calls" would simply inform potential clients that the lawyers at the firm make house calls on prospective clients. Applicant makes it abundantly clear what the meaning of the slogan would be when it includes an actual photograph apparently of a simulation of a house call by an attorney. Because it would be so clear what the phrase "we make house calls" would mean to potential clients, the advertisement goes on to explain the limited circumstances of when the lawyers for the firm "make house calls" by explaining that "Home & Hospital Consultation Available for the Seriously Injured."

Therefore, the evidence made of record by the Examining Attorney and the specimens make it clear that the likely reaction of the average consumer will be to the slogan. They will likely regard the slogan as simply informational matter that informs them that these lawyers

make professional visits to homes, i.e. they make house calls.

While it is true that, for a slogan to be registrable on the Supplemental Register, it does not require a great deal of ingenuity or creativity, the slogan WE MAKE HOUSE CALLS is almost totally devoid of any creativity or ingenuity. Indeed, it is perhaps the most direct and unimaginative way to inform potential customers that a law firm provides the service of making house calls. Applicant argues that: "There is certainly nothing in the record that would support a finding that it is 'a relatively common practice' in the legal field to make a claim that a lawyer makes house calls." Applicant's Appeal Br., p. 5. The fact that many lawyers may not make house calls is not the test. The evidence clearly shows that lawyers are among the many professions that make "house calls." Applicant's slogan is a remarkably mundane way to convey this information to potential clients. It is not the unusual nature of the service that makes a slogan creative; it is the ingenuity of the slogan itself. The slogan "All our lawyers are admitted to the bar in all 50 states" may be unusual because few lawyers, if any, are admitted to the bar of all 50 states, but the slogan itself is a mundane way of informing potential clients of this unusual fact.

Similarly, applicant's slogan informs potential clients of what might be perceived as the somewhat unusual service that its lawyers make house calls. However, it does not do so in a manner that meets the low threshold for registrability on the Supplemental Register.

Also, the fact that applicant's exact phrase was not found in the search of the electronic database is not significant. In re Melville Corp., 228 USPQ 970, 971 (TTAB 1986) ("The fact that applicant may convey similar information in a slightly different way than others is not determinative").

Finally, applicant also points out that it uses the phrase "we make house calls" in its seal or crest along with its firm name, initials, and a design. We note that by depicting its mark in a typed drawing, applicant is not claiming any particular style for its mark. Placing informational matter in a seal does not, by itself, convert unregistrable matter into registrable matter. See, e.g., In re Franklin Press, Inc., 597 F.2d 270, 201 USPQ 662 (CCPA 1979) (Applicant permitted to disclaim, rather than delete, informational phrase "Employees represented by ITU, IPPU & GCU & GAIU" in its mark in a seal design). The additional use in its seal does not change the meaning of the slogan. Applicant's slogan is an ordinary and direct

way of letting potential clients know that its lawyers make home visits; the evidence shows that other lawyers are described as making house calls; and applicant's own specimens demonstrate that potential clients would understand from the context that the slogan was informational. Therefore, the slogan is incapable of distinguishing the services of applicant from those of others.

Decision: The refusal to register is affirmed.